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INFRINGEMENT CASES IN PATENT LAW.

THE question, whether a machine infringes the monopoly of a patent, is one of the most important and common questions of the patent law. It is also in many cases most difficult to answer. It is proposed in this paper to give a short review of some of the cases in which the question has arisen. Obviously the process of answering this question consists of two parts; first, construing the patent, that is, finding what machine it covers, and, second, seeing whether the machine in question is such a machine. These two processes, however, are often necessarily or conveniently carried on together.

The first, and by far the most important, point is to find out what has been done in the same line, before the patentee procured his patent, or, in technical language, "the state of the art." A learned judge in England was once asked what, in his opinion, were the three most important requisites to success at the bar. He replied, "The first requisite is animal spirits, the second and third are also animal spirits." So, in constructing a patent, the first question is the state of the art; the second and third are also the state of the art; for, however broad the language of the patent may be, its effect will be limited to that portion of the device described which was new in the art at the time of the alleged invention.¹

Only by knowing what has already been invented in the same line of machinery can it be decided what the inventor in question has really added to the art.²

Of course, the scope of the patent may be limited in other ways; for instance, one who has made an invention occupying a space in the mechanical arts previously wholly unoccupied may yet, by a badly drawn claim, limit himself to a much narrower

¹ *Burden v. Corning*, 2 Fish. 477; *Bruff v. Ives*, 14 Blatchf. 198; *Estabrook v. Dunbar*, 10 Off. Gaz. 909; *Brown v. Selby*, 2 Biss. 457; *Webster Loom Co. v. Higgins*, 15 Blatchf. 446; *Parsons v. Colgate*, 25 Off. Gaz. 203; *Rubber-Coated Harness Trimming Co. v. Welling*, 97 U. S. 7; *Duff v. Sterling Pump Co.*, 107 U. S. 636.

² *Pitts v. Wemple*, 1 Biss. 87.

patent than his invention deserves, because the courts hold that the inventor is bound by what he claims and cannot expand the claim of his patent by showing that he actually invented another and broader invention.¹ But the final and necessary limitation of the construction of the patent, supposing it to be skilfully drawn so as to cover the whole invention, is the extent of invention embodied in devices not previously known to the art.²

One of the important results of finding the state of the art is, to use a Celtic form of expression, to find that there is no art, that is to say, finding that there was no machine previous to the invention in question which did the thing that the invention in controversy does. The invention then becomes what is called a primary or pioneer invention, and is entitled to certain privileges of construction which have been considered in a recent decision of the Supreme Court of the United States, to which further reference will be hereafter made.³

On the other hand, the search into the state of the art may result in showing that other machines for doing the same thing existed previous to the invention in controversy, but that this latter is an improvement in some respects over previous machines, in which case the construction is limited; for it is held that if an invention was merely an improvement on a known machine, the invention, though patentable, would not exclude others from making other improvements on the same machine by the use of a different form or combination, although the second improvements performed the same functions as the first.⁴ Or in other words, a patent for a primary invention covers all modes of producing the new result by any equivalent mechanisms, while a patent for a secondary invention covers only the specific means for effecting the improvement which the patentee specified or its mechanical equivalent.⁵

The peculiar privilege of construction, accorded to the patent involved in the recent decision of the United States Supreme Court above referred to, applies with equal force to all pioneer

¹ *Johnson v. Root*, 1 Fish. 351; *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U. S. 274; *Lehigh Valley Railroad v. Mellen*, 104 U. S. 112.

² *Cases supra*.

³ *Morley Machine Co. v. Lancaster*, 129 U. S. 263.

⁴ *McCormick v. Talcott*, 20 How. 402, 405.

⁵ *Railway Co. v. Sayles*, 97 U. S. 556.

inventions, using this phrase in the sense of a machine for doing a new thing, something that has not been done before.¹

The privilege consists of giving the patent a wide range of construction, to include machines accomplishing the same result by mechanisms which are proper equivalents of the invention ; and it is in the meaning of this word "proper" that the real force of the decision lies. Every patent for however small an improvement on a known machine covers any other machine which is composed of strict mechanical equivalents for the devices described in the patent.² But it is evident that the narrower the invention, the fewer forms of infringing machines will be found. It is like any defining process. Thus, take the phrase "a man." This would describe any one of the adult male population of the earth. Limit it by the adjective "white," and a much smaller number of persons come under it. Make it a white man residing in Boston, and it will apply to fewer still ; and make it a white man residing in Boston named Ebenezer Jones, and the probabilities are that not more than two or three will be found to whom the phrase applies. It is similar with patents. A patent for a sewing-machine—supposing it to be the pioneer patent—covers a large range. Every one who makes a sewing-machine, acting in the manner described in the patent, is an infringer. Adding a tension to a sewing-machine would cover a smaller number of infringers, and would require a stricter conformity to the mechanism described in the patent. Putting an improvement on the tension, would again be still more limited. The real question which underlies the whole rule as to equivalents is whether the defendant uses the thing that the plaintiff invented, or the equivalent of that thing, however broad it may be.³

The subject of equivalents was considered at length in the Morley case before referred to, and the proposition stated by the court on the point, was substantially to the effect that when a person is the first inventor of a machine which accomplishes a new result, by a combination of mechanisms, another machine is an infringement of the patent therefor, in which such combination of mechanisms exists ; provided that each mechanism, individually considered, is a *proper* equivalent for the corresponding mechanism

¹ Proctor v. Bennis, L. R. 36 Ch. Div. 740.

² Imhaueser v. Buerk, 101 U. S. 655, 656.

³ Crompton v. Knowles, 7 F. R. 199.

in the original invention ; and it makes no difference that in the infringing machine one or more of the combined mechanisms is more simple or different in mechanical construction, so long as they perform each the same function as the corresponding mechanism in the original machine, in substantially the same way, and are constructed to produce the same result.¹

The machines involved in this case were machines for sewing on buttons to the uppers of buttoned boots. Both machines used three mechanisms combined : a mechanism for feeding the buttons one by one to the sewing mechanism, a mechanism for sewing them on to the leather, and a mechanism for feeding along the leather so as to space the buttons as they were sewed on. It was admitted by the defendants' expert that the leather-feeding devices were substantially the same. The case, therefore, turned on the question whether the other two of the three combined devices were equivalents in both machines. The court held that they were,² using the qualifying adverb "substantially."

The important part of this decision may be said to depend upon the use of the words "substantially" and "proper" as quoted above. The words show the tendency of the court to give the patent a broad scope, and perhaps the best account to render of the "pioneer patent" rule would be to say that it is a tendency of the court to find infringement when the machine accomplishes a new result. This tendency was stated by Vice-Chancellor Wood, as follows : "When the thing is wholly novel, and one which has never been achieved before, the machine itself, which is invented, necessarily contains a great amount of novelty in all its parts, and one looks very narrowly and very jealously upon any other machines for effecting the same object to see whether or not they are merely colorable contrivances for evading that which has been done before. When the object itself is one which is not new, but the means only are new, one is not inclined to say that a person who invents a particular means of doing something which has been known to all the world long before, has a right to extend very largely the interpretation of those means which he has adopted for carrying it into effect."³

When a new machine is invented which accomplishes a new result, it generally is composed of a combination of well-known

¹ 129 U. S., pp. 283, 284.

² p. 286 ad fin.

Curtis v. Platt, 3 Ch. Div. 134, p. 136.

mechanical parts, and the cases above cited turned on the question whether those parts or their equivalents were employed in the infringing machine. It is in this connection that the doctrine of equivalents chiefly comes into play; for when such a machine comes into existence and is successful commercially, the ingenuity of numerous mechanics is put to work to devise machines which will accomplish that new result, and yet not be infringements, or if that is impossible, yet shall not appear to be infringements. Most ingenious shuffling and making of the various elements has been resorted to in many cases, and to any one not trained in picking out the various elements of the machine, the completed structures would seem to differ *toto coelo*; and yet when the working parts are analyzed, it is evident that one machine does exactly what the other does, and by precisely the same means, or their strict mechanical equivalents. The questions that arise as to infringement, are questions of mechanics, and therefore do not strictly come within the limits of a legal discussion. Moreover, the question of infringement being one of fact, and being decided in equity by the judge who hears the case, the legal principles are applied without that definiteness of statement which exists when different tribunals pass upon the law and facts of a case. There are, however, certain principles which have been well settled by the courts. Thus, as has been already said, equivalents in a machine do not take it out of the patent. If a patent covers a combination of three mechanisms, *e.g.*, a sewing mechanism, a feeding mechanism, and a mechanism to supply buttons to be sewed on,—as in the Morley case above referred to,—any machine which has such mechanisms is an infringement, although it does not employ precisely the same mechanisms, but does employ mechanisms which are equivalent in their action and results,¹ but a combination of old elements is not infringed by the use of a portion of its mechanism, *e.g.*, if a patent provides for the use of four elements, a machine which effects the same result by the use of three of those elements does not infringe the patent.²

Another well-settled rule is that a machine which is an improvement on a prior patented machine infringes the patent so far as it

¹ *LeBaw v. Hawkins*, 6 Off. Gaz. 724; *Atlantic Giant Powder Co. v. Goodyear*, 13 Off. Gaz. 45; *Potter v. Schenck*, 1 Biss. 515.

² *Cross v. Livermore*, 21 Off. Gaz. 139; *Bell v. Daniels*, 1 Bond, 212; *Bridge v. Brown*, 1 Holmes, 205; *Brooks v. Fiske*, 15 How. 212; *Dunbar v. Myers*, 94 U. S. 187.

uses that patented mechanism, although by its improvements it produces a better result.¹

Such a case as this, however, raises an important question as to the damages recoverable, for, if the sale of the machine has depended largely upon the improvement, the original patentee cannot recover his usual damages.²

An important rule of construction of patents which affects the question of infringement, has already been alluded to, viz. : that a patentee is held to be bound by the claim of his patent.³

This rule, in spite of its apparent definiteness, is in reality almost worthless on account of its corollary, that a claim must be construed according to the specifications and drawings.⁴

The admission of these additions to the claim puts the question of infringement largely in the power of the court ; for the construction of the claim so enlarged offers a great opportunity for enlarging the scope of a meritorious invention, and narrowing the effect of a mere improvement. In the application of this rule, the effect of the pioneer invention rule appears again, and if the invention is of a machine which performs a new result, the courts are apt to enlarge the construction of the patent. In the *Morley* case, for instance, the patent contained drawings and descriptions of certain definite devices for sewing on the buttons, these devices being needles of a certain form. The claim was simply for sewing appliances ; and the specification also, after describing the needles shown in the drawings, added that these machines were only one form of the different mechanisms which the inventor had contemplated as carrying out his inventions, and specified others, but did not specify the specific devices of the defendant's sewing mechanism. The court said, " That in a pioneer patent, with claims drawn as in the patent in question, the special devices set forth are not necessary constituents of the claim." ⁵

Unquestionably, if the patent had only been for an improvement on a machine already known, the court would have held the inventor bound by the devices which he set forth as embodying his invention.

¹ *Stainthorp v. Humiston*, 4 Fish. 107 ; *Frost v. Marcus*, 13 Fed. Rep. 88 ; *Robertson v. Blake*, 94 U. S. 728 ; *Tilghman v. Proctor*, 102 U. S. 707.

² *Garretson v. Clark*, 4 Ban. & Ard. 538 ; *Philp v. Nock*, 17 Wall. 460.

³ *Dennis v. Cross*, 3 Biss. 389 ; *Fisher v. Craig*, 3 Sawy. 69 ; *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U. S. 274.

⁴ *Blanchard v. Sprague*, 3 Sumn. 279 ; *Dederick v. Cassell*, 9 Fed. Rep. 312.

⁵ 129 U. S. 284.

This cursory examination of some of the decisions affecting the question of infringement of patents will suffice to show how well the courts have succeeded in arriving at substantial justice in cases which involve the application of legal principles to a wholly new kind of facts, where the main questions are of mechanics, and in most cases, questions calling for the highest degree of mechanical skill, as well as a general knowledge of the state of the mechanical arts. Whether the present method of deciding such questions is the best possible one, seems to be somewhat doubtful, in view of the great additional labor which such cases throw upon the Supreme and Circuit Courts, and a movement has been made in the direction of establishing a court for the especial purpose of trying patent cases, with a limited appeal only to the Supreme Court. Such an arrangement would be regarded with favor by those lawyers whose business is in that line, and would unquestionably advance the speedy trial of these and other cases in the Supreme Court.

Simon G. Croswell.

BOSTON, June, 1889.

THE HISTORY OF THE REGISTER OF ORIGINAL WRITS.¹

III.

LET us pass on to a new reign. Registers of Edward I.'s time are by no means uncommon. I believe that we have at Cambridge no less than seven which, in the sense defined above, may be ascribed to that age, and there are many at the British Museum. The most meagre of them is far fuller than those Registers of Henry III.'s reign of which we have spoken. To give an idea of their size I may mention a MS. at the Museum (Egerton 656), in which the writs are distributed into groups of sixty; there are seven perfect groups followed by a group

¹ In my first article a few misprints occurred which I may be allowed to correct.

On page 99, line 20, for Henry II. read Henry III. I have not seen and hardly hope to see a MS. Register of the twelfth century. The Cottonian MS. referred to on page 110 is Julius D. II. The French words on page 111 should be *a son ascient*. The Cambridge MS. spoken of on page 113 is li. vi. 13.